

## **REMARKS**

This is in response to the action dated December 6, 2006.

The action states that Claims 8, 17, 18, 36, 37, 58, 59 and 61 ~~and~~ 69 are withdrawn. Despite the request for clarification regarding the restriction requirement, none has been given. Instead, a warning was issued by the examiner. To avoid a non-compliant amendment and to further progress in the prosecution of the application, the applicant withdraws all of the above-identified claims, but maintains that portions of the restriction requirement are clearly defective at least as set out in the previous response.

Claims 1, 2, 4-6, 10, 13 and 15 were rejected under 35 U.S.C. §103(a) by the combination of White '069 and Correnti '157.

The examiner, in the present action, states that White has a central chamber (despite the apparent contradiction in the same action that White "...teaches a nipple with a substantially solid tip..."). In fact, it is true that the White nipple includes a chamber, which is an annular chamber 34 that runs about the outer perimeter of an internal elongated member disposed within the hollow nipple tip and also includes a different chamber, which is a hollow 62 formed in the elongated member to provide resilience against biting by permitting the elongated member to collapse. The objective and function of the elongated member and chamber provided in the member in the White nipple is directed to providing resilience against biting.

The nipple of Correnti is also hollow. Correnti is a hollow nipple with a tubular member (T) arranged axially in the hollow nipple and in fluid communication with a discharge port (11). Both the White and Correnti nipples are hollow or have one or more chamber(s) which are part of the nipple and related to specific functions of the respective nipples, both of which being unrelated in form and function to the present invention.

The combination of White and Correnti does not provide all of the limitations, either in form or function, of the present invention either in teaching or suggestion. White has a chamber to permit collapse of the nipple and Correnti has a tubular member to "prevent collapse of the head and neck portions of the nipple." It simply does not follow logically that the combination of these references renders obvious a substantially solid nipple in either form or function.

The action suggests by combining White with Correnti, that provision of a duct in the chamber of White is a modification which makes the nipple substantially solid. However, the action fails to provide any reasoning why the provision in the nipple of White of a duct (especially since there is no suggestion to modify White, except with hindsight) would make the chambered White nipple into a substantially solid nipple, because the provision of the duct does not remove the chamber(s) or change the chamber's size, shape or function.

The action states that the White nipple has a "substantially solid tip." The "substantially solid nipple" of the present claims is not the same as the tip of the White nipple. Furthermore, a nipple tip is not necessarily equivalent to a nipple. It is not clear from the action whether the action is merely using different terminology to describe the nipple of White or is actually asserting that a nipple tip is the same thing as a nipple as set forth and claimed in the presently claimed invention. Since the examiner has not demonstrated that the nipple tip of White is the same thing as a nipple as set forth and claimed, the position is taken that the action is applying non-analogous structure of the White device to the presently claimed invention.

Because White and Correnti use different structures to solve different problems in nipples, there is no logical reason to combine White and Correnti except in an improper use of hindsight. Nevertheless, the combination of White and Correnti still creates a hollow nipple

Claims 3, 14, 16, 19-24, 32-35, 38, 39, 42-44, 47, 54-57, and 60 are rejected under 35 U.S.C. §103(a) in view of the above rejection and Ishimaru. White and Correnti are distinguished above and Ishimaru is used to teach the use of a soft material to provide more natural nursing. Ishimaru also shows a hollow nipple. There is no teaching of a substantially solid nipple in either reference so *prima facie* obviousness is not present . Furthermore, there is no logical way to arrive at the present claims using Ishimaru in combination with White and Correnti. In fact, all three hollow nipples shown strongly teach away from the presently claimed invention.

Claim 39 differs from other independent claims in at least by the specification of a low durometer material. This is not shown or suggested by any of the references cited. Therefore, the above claim cannot be rendered obvious.

Claims 9, 30, 31, 45, 47, 48 and 53 were rejected under 35 U.S.C. §103(a). Morano is used in the action to show the features of a co-molded nipple and indicia. It should be noted that Morano does not supply the above deficiencies or logical reasoning to either combine or modify the references to arrive at the presently claimed invention and therefore these claims are not rendered obvious.

Claim 7 was rejected under 35 U.S.C. §103(a) in view of White, Correnti and Dunn. Dunn is used in the action to show two-part nipples and color coded indicia. However, Dunn does not supply the above-noted deficiencies or logical reasoning to either combine or modify the references to arrive at the presently claimed invention and therefore these claims are not rendered obvious.

Claims 11, 12, 70 and 71 were rejected under 35 U.S.C. §103(a). Parkin was used to show a vent. Parkin, therefore, does not supply the above deficiencies or logical reasoning to either combine or modify the references to arrive at the presently claimed invention and therefore these claims are not rendered obvious.

Claims 25-29 and 49-52 were rejected under 35 U.S.C. §103(a). Fort was used to show a two part mount. Fort, therefore, does not supply the above deficiencies or logical reasoning to either combine or modify the references to arrive at the presently claimed invention and therefore these claims are not rendered obvious.

Claim 46 was rejected under 35 U.S.C. §103(a) as applied to Claims 39 and 45 in view of Yamamoto. Yamamoto is used in the action to show a mounting portion with a different hardness than the nipple portion. However, Yamamoto does not supply the above-noted deficiencies or logical reasoning to either combine or modify the references to arrive at the presently claimed invention and therefore these claims are not rendered obvious.

Claim 72 was rejected under 35 U.S.C. §102(b) by Morifuji. Claim 72 has been canceled  
All of the pending claims are in allowable condition. Reconsideration is requested.

Respectfully submitted,



Date: May 7, 2007

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